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Remarks/Arguments

This Response is provided in response to the non-final Office Action mailed April 6, 2006, in which the Examiner rejected claims 1-9, 13, and 15-29 under 35 U.S.C. §102(e) as being anticipated over the prior art, and in which the Examiner rejected claims 10-12 and 14 under 35 U.S.C. §103(a) as being obvious in view of the prior art. In view of the present amendments and remarks, the Applicants believe that claims 1-29 are presently in condition for allowance.

Claim Amendments

The amendments to independent claims 1, 15-16, and 21 have not been made for reasons of patentability, but rather have been amended to more particularly point out and distinctly claim the subject matter regarded by the Applicants as their invention. The amendments to the claims have been made to make explicit that which was implicitly inherent and within the ordinary meaning of terms of art used within the language of claims, and as would be understood by one of ordinary skill in the art.

Rejection of Claims Under 35 U.S.C. §102(e)

The Office Action rejected claims 1-9, 13, and 15-29 under 35 U.S.C. §102(e) as being unpatentable over United States Patent No. 6,763,380 issued to Mayton et al., July 13, 2004 (Mayton '380). The Applicants respectfully traverse this rejection.

Legal Precedent

Anticipation means a lack of novelty, and is a question of fact which is reviewed by the reviewing court using a substantial evidence standard. *Brown v. 3M*, 60 USPQ2d 1375 (Fed. Cir. 2001); *Baxter Int'l, Inc. v. McGaw, Inc.*, 47 USPQ2d 1225 (Fed. Cir. 1998). To anticipate a claim, every limitation of the claim must be found in a single prior art reference, arranged as in the claim. *Karsten Mfg. Corp. v. Cleveland Golf Co.*, 58 USPQ2d 1286 (Fed. Cir. 2001). *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 122 S.Ct. 1831 (2002). Each such limitation must be found either expressly or inherently in the prior art reference. *Schering Corporation v. Geneva Pharmaceuticals, Inc.*, 02-1540, Decided August 1, 2003 (Fed. Cir. 2003). Accordingly, the Applicants need only point to a single

element not found in the cited reference to demonstrate that the cited reference fails to anticipate the claimed subject matter.

The cited reference fails to show testing over multiple paths between two devices as recited by independent claims 1, 15, 16, and 21.

As discussed in a telephonic interview with Examiner Shin on July 17, 2006, one embodiment of the Applicants' present invention is directed to methods and apparatus for performance measurement of different network routes between devices. *See e.g.*, specification pg. 5, lines 21-22. Typically, a network includes multiple paths between a first and a second device. *See e.g.*, specification pg. 5, lines 22-23. A preferred embodiment of the Applicants' present invention includes a first test of a first type conducted over a first path between a first and second device, and a second test of a first type conducted over a second path between a first and second device. *See e.g.*, specification pg. 5, lines 23-25. In this embodiment, the test being conducted is ran over two separate paths running between a first and second device, using the same test over each path and running the tests simultaneously so that comparative data can be derived regarding each of the separate paths. *See e.g.*, specification pg. 5, lines 25-27.

Turning to the claims, claim 1 recites *inter alia*,

"conducting a first performance test of a first type ***over a first path*** of the plurality of paths between the first and second devices;
conducting a second performance test of the first type ***over a second path*** of the plurality of paths between the first and second devices;"
(Emphasis Added)

Similarly, claim 15 recites *inter alia*,

“conducting a first performance test of a first type *over a first path* of a plurality of paths between a first and second devices;
conducting a second performance test of the first type *over a second path* of the plurality of paths between the first and second devices;”
(Emphasis Added)

Likewise, claim 16 recites *inter alia*,

“means for conducting a first performance test of a first type *over a first path* of the plurality of paths between the first and second devices;
means for conducting a second performance test of the first type *over a second path* of the plurality of paths between the first and second devices;”
(Emphasis Added)

Finally, claim 21 recites *inter alia*,

“a first device coupled to a first access network;
the first access network coupled to a first and a second transport networks;
a second access network coupled to the first and the second transport networks;
a second device coupled to the second access network; and
wherein a performance test is conducted between the first device and the second device *over each of the first and second transport networks simultaneously.*”
(Emphasis Added)

Thus, the Applicants' claimed subject matter recites the use of a common test for simultaneous testing over *two* of a *plurality* of paths between two devices. These tests, for example, include testing along a path 1 between points A and B and testing along a path 2 between points A and B. In sharp contrast, Mayton '380 describes a system in which console 20 tests endpoint 14, endpoint 15, endpoint 16, and endpoint 17, each through a *single path*. See col. 8, lines 27-32, col. 13, lines 49-54, *see also* figure 2. For simplicity, we will examine the procedure for testing endpoint 14. A baseline test is run on the *single path* between console 20 and endpoint 14 to determine a baseline test. See col. 12, line 66 – col. 13, line 3. These baseline tests are executed periodically (i.e., subsequent in time and not simultaneously), and are used as a base value to determine if the *single path* between endpoint 14 and console 20 has a point of outage or is performing poorly and needs debugging. See col. 13, lines 14-20. Therefore, the system of Mayton '380 repeatedly tests along a *single path* between two network devices at periodic times to determine the performance measurements on that *single path*. Thus, measurements are taken along a *single path* between points A and B at time 1, then measurements are taken again along the same *single path* at some time 2.

This testing of Mayton '380 along a *single path* multiple times (testing A to B periodically along a single path) is not identical to the use of a common test for simultaneous testing over a *first and a second path* of the plurality of paths between two devices (testing A to B on first path 1 and testing A to B on a second path 2 at the same instant), as claimed by the Applicant. Therefore, Mayton '380 fails to show every limitation of independent claims 1, 15, 16, and 21. Furthermore, based at least upon their dependency to claims 1, 16, and 21, claims 2-14, 17-20, and 22-29 are not anticipated by Mayton '380. For at least these reasons among others, the Applicants respectfully request withdrawal of the rejections under 35 U.S.C. § 102, and passage of claims 1-29 to allowance.

The cited reference fails to show testing over two paths simultaneously as recited by independent claims 1, 15, 16, and 21.

Claims 1, 15, and 16 recite *inter alia*,

“the first and the second performance tests are performed
simultaneously”
(Emphasis Added)

Similarly, claim 21 recites *inter alia*,

“a performance test is conducted between the first device
and the second device over each of the first and second
transport networks *simultaneously*”
(Emphasis Added)

The Examiner states “performance tests completed utilizing user initiation can be performed essentially simultaneously, since initiation can be performed substantially simultaneously.” *See* Office Action pg. 3, lines 19-21. The Examiner points to Mayton '380 (col. 13, lines 30-32) for support of this statement. *See* Office Action pg. 5, lines 4-6, 13-15, and 19-21. This section of Mayton '380 merely discloses that a user may initiate a test, not that multiple tests are performed simultaneously. Even if a user were to run the multiple tests, as proposed by the Examiner, the tests would necessarily have to be run *sequentially*, not *simultaneously*, since the user would not be able to physically initiate multiple tests in the same instant.

Contrary to the Examiner's position, it appears that Mayton '380 is more properly read as describing performing multiple tests over a single path between two devices *periodically*, not *simultaneously*, to provide baseline comparison measurement values for the single path. *See* col. 3, lines 25-32. There is no showing within the four corners of the reference of performing multiple tests simultaneously, as required by §102. Thus, Mayton '380 fails to show every limitation of independent claims 1, 15, 16, and 21. Furthermore, based at least upon their dependency to claims 1, 16, and 21, claims 2-14, 17-20, and 22-29 are not anticipated by Mayton '380. For at least these reasons among others, the Applicants respectfully request withdrawal of the rejections under 35 U.S.C. § 102, and passage of claims 1-29 to allowance.

Rejection of Claims Under 35 U.S.C. §103(a)

The Office Action further rejected claims 10, 11, and 14 under 35 U.S.C. §103(a) as being unpatentable over Mayton '380 in view of United States Patent No. 6,360,268 issued to Stephen Silva et al., March 19, 2002 (Silva '268). This rejection is respectfully traversed.

Legal Precedent

The United States Court of Appeals for the Federal Circuit have provided specific guidance regarding the kind of factual findings needed to determine a reason, suggestion, or motivation to combine references in support of a prima facie showing of unpatentability under 35 U.S.C. §103(a). "The reason, suggestion, or motivation to combine may be found explicitly or implicitly: 1) in the prior art references themselves; 2) in the knowledge of those of ordinary skill in the art that certain references, or disclosures in those references, are of special interest or importance in the field; or 3) from the nature of the problem to be solved, "leading inventors to look to references relating to possible solutions to that problem." *Pro-Mold & Tool Co. v. Great Lake Plastics, Inc.*, 75 F.3d 1568, 1572, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996) (internal citations omitted); *In re Rouffet*, 149 F.3d at 1357, 47 USPQ2d at 1458. While the references need not expressly teach that the disclosure contained therein should be combined with another, see *Motorola, Inc. v. Interdigital Tech. Corp.*, 121 F.3d 1461, 1472, 43 USPQ2d 1481, 1489 (Fed. Cir. 1997), the showing of combinability must be "clear and particular." *In re Dembiczak*, 175 F.3d at 999, 50 USPQ2d at 1617." *Ruiz v. A.B. Chance Co.*, 57 USPQ2d 1161 (Fed. Cir. 2000).

The cited references, taken alone or in combination, fail to teach or suggest features recited by claims 10, 11, and 14.

Claims 10, 11, and 14 depend from independent claim 1, and include all limitations of independent claim 1. As discussed above in the section titled "Rejection of Claims Under 35 U.S.C. §102(e)", Mayton '380 fails to teach or suggest the recitation in claim 1 of conducting a first and second performance test of the same type over a *first and second path* of a plurality of paths between the first and second devices. Mayton '380 also fails to

teach or suggest the recitation in claim 1 of “the first and the second performance tests are performed **simultaneously**.” Emphasis Added. Moreover, Silva '268 supplies neither the missing elements nor a “clear and particular” showing for the combinability of the two references. Thus, neither Mayton '380 nor Silva '268, taken alone or in combination, teach the above recitations of claim 1. Due to at least the dependencies of claims 10, 11, and 14 on claim 1, the cited references, taken alone or in hypothetical combination, cannot render obvious claims 10, 11, and 14. For at least these reasons, the Applicants request withdrawal of the rejection of claims 10, 11, and 14 under 35 U.S.C. §103(a), and passage of same to allowance.

Rejection of Claims Under 35 U.S.C. §103(a)

The Examiner further rejected claim 12 under 35 U.S.C. §103(a) as being unpatentable over Mayton '380 in view of U.S. Publication No. 2003/0036865, inventor ZhangQing Zhuo et al., February 20, 2003, (Zhuo '865).

The cited references, taken alone or in combination, fail to teach or suggest features recited by claim 12.

As discussed above in the section titled “Rejection of Claims Under 35 U.S.C. §102(e)”, Mayton '380 fails to teach or suggest the recitation in claim 1 of conducting a first and second performance test of the same type over a *first and second path* of a plurality of paths between the first and second devices. Mayton '380 also fails to teach or suggest the recitation in claim 1 of “the first and the second performance tests are performed **simultaneously**.” Emphasis Added. Moreover, Zhuo '865 supplies neither the missing element nor a “clear and particular” showing for the combinability of the two references. Thus, neither Mayton '380 nor Zhuo '865, taken alone or in combination, teach the above recitations of claim 1. Due to at least the dependency of claim 12 on claim 1, the cited references, taken alone or in hypothetical combination, cannot render obvious claim 12. For at least these reasons, the Applicants request withdrawal of the rejection of claim 12 under 35 U.S.C. §103(a), and passage of same to allowance.

Conclusion

The Applicants respectfully submit that all pending claims should be in condition for allowance. This Response is intended to be a complete response to the non-final Office Action mailed April 6, 2006.

However, if the Examiner believes certain amendments are necessary to clarify the present claims or if the Examiner wishes to resolve any other issues by way of a telephone conference, the Examiner is kindly invited to contact the undersigned attorney at the telephone number indicated below.

Respectfully submitted,

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